

Appeal Brief
Appl. No. 10/758,862
Submitted on November 5, 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.:	10/758,862	Confirmation No.:	8001
Applicant:	David Kümhyr.		
Filed:	January 16, 2004		
TC/A.U.	4172		
Examiner:	Jessica Lemieux		
Docket No.:	AUS920030908US1		
Customer No.:	46129		
Title:	METHOD FOR AUTOMATICALLY PREPARING PAYMENT INSTRUMENTS AT A POINT-OF-SALE LOCATION		

Honorable Commissioner
P. O. Box 1450
Alexandria, Virginia 22313-1450

**APPELLANT'S BRIEF
IN RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. § 1.192**

This brief is filed in triplicate in support of the previously filed Notice of Appeal, which was filed November 18, 2008, which appealed from the decision of the examiner dated June 18, 2008, rejecting claims 1-4, 8-12 and 19. The fee required under 37 C.F.R. § 1.17(c) for filing a brief in support of an appeal is provided in the Transmittal of Appeal Brief filed herewith.

2. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

3. STATUS OF CLAIMS

Claims 1-4, 8-12 and 19 are pending in this application; claims 1-4, 8-12 and 19 have been appealed. Claim 12 has been canceled. No claims have been allowed.

4. STATUS OF AMENDMENTS

Applicant amends claim 8 as part of this appeal to correct a clerical.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1 describes a method for preparing check payment instrument using a payment terminal at the point-of-sale location comprising first calculating a total sale amount [0037], [0038], Figure 6, step 30. In response to a user input, activating the check writing process [0037], [0038], Figure 6, step 31. Next, a blank check from a payee is received and scanned at a payment terminal [0037], [0038], Figure 6, step 32. Retrieving payee information from the scanned check [0037], [0038], Figure 7, step 43. Transaction information from the current transaction is also retrieved [0037], [0038], Figure 7, step 43. At this point, sale transaction information and payee information is compiled for inclusion on a new check document [0038], Figure 7, step 44. The next step is to print the transaction information and payee information on a newly created check document in defined check fields [0038], Figure 7, step 45. The newly created check document is then displayed for signature by the payee [0038], Figure 7, step 46. Lastly, the original check document supplied by the payee is destroyed [0038].

Claim 9 describes computer program product in a computer readable storage medium for preparing check payment instrument using a payment terminal at the point-of-sale location comprising first instructions calculating a total sale amount [0037], [0038], Figure 6, step 30. In response to a user input, instructions activating the check writing process [0037], [0038], Figure 6, step 31. Next, there are instructions for receiving a blank check from a payee and instruction for scanning the received blank check at a payment terminal [0037], [0038], Figure 6, step 32. Instructions for retrieving payee information from the scanned check [0037], [0038], Figure 7, step 43. Next there are instructions for retrieving information from the current transaction is also retrieved [0037], [0038], Figure 7, step 43. At this point, instructions compile sale transaction information and payee information for inclusion on a new check document [0038], Figure 7, step 44. The next instructions print the transaction information and payee information on a newly created check document in defined check fields [0038], Figure 7, step 45. Instructions display the newly created check document is then displayed for signature by

the payee [0038], Figure 7, step 46. Lastly, instructions destroy the original check document supplied by the payee [0038].

6. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

6.A. – Was 35 U.S.C. § 103(a) properly applied against claims 1, 3-4 and 8-9 as being unpatentable over Saffarian US Patent 6,796,488 and in view of Buttridge (US Patent Publication 20030033252).

6.B. – Was 35 U.S.C. § 103(a) properly applied against claims 2, 11 and 12 as being unpatentable over Saffarian U.S. Patent 6,796,488 in view of Buttridge (U.S. Patent Publication 20030033252).

6.C. - Was 35 U.S.C. § 103(a) properly applied against claim 19 as being unpatentable over Saffarian U. S. Patent 6,796,488 in view of U.S. Patent 6,097,834 to Krouse et al.

7 ARGUMENTS IN SUPPORT OF SEPARATE PATENTABILITY

7a. Arguments in response to 6a.

Saffarian describes an automated check encoding system at a point-of-sale includes a point-of-sale register for determining a transaction amount, and an input device coupled to the point-of-sale register for receiving the transaction amount and determining a check amount in response to receiving an input from a user. A check encoder is coupled to the point-of-sale register and the input device for receiving the check amount and encoding the check amount in a machine-readable format at a predetermined location on a blank check.

Although embodiments of Applicant's present invention also describes a method and system for automatically preparing payment instrument at a point-of-sale location, Applicant's invention as amended contains features not described in Saffarian. Embodiments of Applicant's invention claims features related to scanning in a blank check document supplied by a payee and retrieving payee information from the blank

check document. This payee information is compiled and printed on a new blank check document. In order to sustain a rejection under 35 U.S.C. 102(e), the cited and relied on reference document must describe each element of the rejected claim. Contrary to the examiner's statement that all elements are disclosed in the cited reference, as amended claims 1 and 9 contain the steps and instructions of:

- retrieving payee information from the scanned check;

- compiling sale transaction information and payee information for inclusion on a new check document;

- printing the transaction information and payee information on a newly created check document in defined check fields; and

- displaying the newly created check document for review and signature by the payee.

are not described in Saffarian. Therefore, the rejection is unsupported by the art and should be withdrawn

Buttridge discloses a system in which in one embodiment includes a point-of-sale terminal or cash register, which is connected to a check imager, a MICR (magnetic ink character recognition) reader, biometric sensor, and a printer. The system integrates electronic check processing into retail operations such as items at a grocery checkout and allows customers to pay for goods or services with a blank check and without write out or sign the blank check.

Buttridge does perform scanning functions which retrieves information from the blank check. However, this information is used as part of an electronic transaction. Buttridge does not use the information from the blank check to produce a new check document as part of the sales transaction. With regard to claim 18, the document produced in Buttridge is for customer service purposes. In embodiments of the present invention, the newly created check document is for the purpose of completing the actual transaction (See figure 7 and [0038]. The original blank check document supplied by the payee is destroyed. In Buttridge information of a prior sales transaction, the check used and payee signature image are compiled and included on a document that can be produced to verify a sales transaction. The document as produced already has a payee

signature included on the document. This signature is from the previous transaction. In the embodiments of the present invention, the payee has the opportunity to manually or electronically sign the newly created check document. Buttridge does not teach or suggest the creation of the new check document for the purpose of completing a transaction. Both Buttridge describes using the original blank check document to complete the transaction.

In order to sustain a prima facie case of obviousness there must be some suggestion of teaching to modify or combine references. If there is no teaching, there is no prima facie case for obviousness. Applicant submits that the Examiner has failed to present a prima facie case of obviousness. As indicated above, Saffarian does not specifically teach the use of scanner techniques or the creation of a new check document. Buttridge does not teach the creation of a new check document for the purpose of having the payee sign the document in order to complete the original sales transaction. The created document in Buttridge contains images of the original blank check and payee signature. Embodiments of the Applicant's present invention provide a completely new check document independent of the images of the initially submitted blank check document. Applicant further asserts that any combination of the cited references will not produce the embodiments of Applicant's present invention.

8. CONCLUSION

In view of the above, Applicant respectfully submits that none of the art of record (alone or in combination) teaches, discloses or even suggests the invention as recited in each of Applicant's claims. Applicant further submits that all of the pending claims are in condition for allowance. Withdrawal of the rejections and passage to issuance is respectfully requested. Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the below listed telephone number.

Respectfully Submitted,



Darcell Walker
Reg. No. 34,945
P. O. Box 25048
Houston, Texas 77265
713-772-1255
November 18, 2008

Claim 1 (Previously presented) A method for preparing check payment instrument using a payment terminal at the point-of-sale location comprising the steps of:

- calculating a total sale amount;
- in response to a user input, activating the check writing process;
- receiving and scanning at payment terminal a blank check from a payee;
- retrieving payee information from the scanned check;
- retrieving transaction information for a current sales transaction;
- compiling sale transaction information and payee information for inclusion on a new check document;
- printing the transaction information and payee information on a newly created check document in defined check fields; and
- displaying the newly created check document for review and signature by the payee; and
- destroying the original blank check document supplied by the payee.

Claim 2 (Previously presented) The method as described in claim 1 wherein said displaying step further comprises outputting the newly created check document from the payment terminal device such that the check document can be physically handled by the payee.

Claim 3 (Previously presented) The method as described in claim 1 further comprising after said displaying step the step of determining whether the customer will submit an electronic signature on the newly created check document.

Claim 4 (Previously presented) The method as described in claim 3 further comprising after said electronic signature determination step, the step of receiving on the newly created check document an electronic signature from the payee.

Claim 5 (Canceled)

Claim 6 (Canceled)

Claim 7 (Canceled)

Claim 8 (Currently Amended) The method as described in claim 3 & further comprising when the determination is that the customer will submit an electronic signature, the step of; retrieving an electronic signature and printing the retrieved signature in a designated signature field on the check.

Claim 9 (Previously presented) A computer program product in a computer readable storage medium for preparing check payment instrument using a payment terminal at the point-of-sale location comprising:

- instructions calculating a total sale amount;
- in response to a user input, instructions activating the check writing process;
- instructions receiving and scanning at a payment terminal a blank check from a payee;
- instructions retrieving payee information from the scanned check;
- instructions retrieving transaction information for a current sales transaction;
- instructions compiling sale transaction information and payee information for inclusion on a new check document;
- instructions printing the transaction information and payee information on a newly created check document in defined check fields;
- instructions displaying the newly created check document for review and signature by the payee; and
- instructions destroying the original blank check document supplied by the payee.

Claim 10 (Previously presented) The computer program product as described in claim 9 wherein said displaying instructions further comprise instructions outputting the newly created check document from the payment terminal device such that the check document can be physically handled by the payee.

Claim 11 (Previously presented) The computer program product as described in claim 10 further comprising after said displaying instructions, instructions determining whether the customer will submit an electronic signature on the newly created check document.

Claim 12 (Previously presented) The computer program product as described in claim 11 further comprising after said electronic signature determination instructions, instructions receiving on the newly created check document an electronic signature from the payee.

Claim 13 (Canceled)

Claim 14 (Canceled)

Claim 15 (Canceled)

Claim 16 (Canceled)

Claim 17 (Canceled)

Claim 18 (Canceled)

Claim 19 (Previously presented) A system for preparing check payment instrument using a payment terminal at the point-of-sale location comprising:

- check feeder mechanism for accepting the check;

- a processor to calculate the amount of a sale;

- a scanner to establish locations on the check for printing information related to the sale;

- a memory location storing information that to be provided related to the sale on the check; and

- a printer for printing the information on the check.

Claim 20 (Canceled)

EVIDENCE APPENDIX

In accordance with 37 CFR 41.37, submitted herein evidence entered by the examiner and relied upon by appellant in the appeal. The examiner in an office letter dated entered the evidence. The evidence includes:

United States Patent Number 6,796,488 - Saffarian

United States Patent Number 6,097,834 – Krouse et al.

United States Patent Publication 20030033252 – Buttridge et al.

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings for this appeal.